

REMARKS

Claims 1-6, 8 and 10-14 have been rejected for alleged failure to provide an enabling disclosure under 35 USC § 112, first paragraph, for allegedly being indefinite under 35 USC § 112, second paragraph, for allegedly being directed to non-statutory subject matter, and claims 1-6, 8 and 10-12 have been rejected also as being directed to non-statutory subject matter. Applicant respectfully requests reconsideration.

The Disclosure is Enabling

Claims 1-6, 8 and 10-14 have been rejected 35 USC § 112, first paragraph, for alleged failure to comply with the enablement requirement. According to the examiner, the disclosure “does not provide a predictable, repeatable and concrete result thereby requiring undue experimentation.” The examiner acknowledges that the specification includes “examples” but contends that those are not specific enough. The examiner fails to explain why the examples are not sufficiently specific and fails to support his conclusion that undue experimentation would be required to practice the claimed invention. Applicant’s disclosure contains examples of how to practice the claimed invention and the examiner’s rejection appears premised on the claims and disclosure being to be limited to a particular industry. The claims are directed to a method of competing in complex contract competitions, which of necessity have varying requirements. The fact that particular contracts may have differing requirements does not mean that the specification must disclose all of the requirements for the various contracts.

Commencing at page 24 of the specification, Applicant provides a detailed example of how to implement the claimed invention in a contract dealing with transportation. The specification teaches one skilled in the art how to practice the invention when two (or more) vendors are competing for the transportation contract. The Applicant provides that example

to enable one skilled in the art to practice the invention. Applicant should not be limited to the preferred embodiment. Moreover, under the Patent Laws, an applicant is "entitled" to a patent unless the invention as claimed fails to comply with the statute.

Moreover, the MPEP at § 2164.01(a) provides a list of factors that need to be considered when addressing the issue of undue experimentation. As noted there, it "is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others." Included in that list are "state of the prior art", the "level of skill in the art", the "level of predictability in the art", the "amount of direction provided by the inventor", the "existence of working examples" and the "quantity of experimentation needed to use the invention". In the present instance, the examiner has previously rejected claims based upon prior US patents, thus indicating that the state of the art indicates that those in the field have familiarity with the general subject matter of the claimed invention. Applicant asserts that the skill level is high, considering the invention is directed to "complex" contracts. Skilled practitioners require fewer details than those less skilled. The Applicant clearly provides direction on how to practice the invention and the application includes at least one working example. Regarding the degree of experimentation required, the rejection fails to address that requirement at all.

It also is to be noted that Office Action of September 14, 2007, claim 15 was deemed allowable subject to being written in independent form. Hence, at least at that time the examiner considered the specification enabling. No explanation has been provided as to why a specification previously deemed enabling is now not enabling.

In view of the above, Applicant asserts that the disclosure is enabling of the claimed subject matter and that undue experimentation is not required.

The Claims are Definite

The examiner asserts that because the claims require “identifying an industry standard”, “assigning numerical values”, “adjusting each of the assigned numerical values” and “framing a response” that the claims are indefinite because “individual interpretation is required”. The examiner does not dispute that industry standards are known, such as outlined in Applicant’s Amendment of April 25, 2008 at page 14. Certainly a claim is not indefinite because one must identify a standard that applies to the industry that the contract pertains to.

Furthermore, the Applicant provides examples on how to assign numerical values, adjust the values, and frame a response. That some human input is required does not render the claims indefinite. Almost all claims require some human input at some level, whether to construct an article, practice a method, etc. The examiner cites no authority to support this rejection.

Claims 1-6, 8 and 10-14 are directed to Statutory Subject Matter

Claims 1-6, 8 and 10-14 have been rejected for allegedly being directed to non-statutory subject matter under 35 USC § 101 because the examiner contends that they “do not provide a predictable, repeatable and concrete result thereby requiring undue experimentation.” The examiner cites to MPEP § 2164.01 (a) which Applicant earlier addressed. Applicant will not repeat those arguments here, but incorporates them by reference.

The examiner cites also to MPEP § 2106 to support this rejection. As noted there, “a determination of the level of ordinary skill of the ordinary artisan in that field” is required. No such determination has been made by the examiner, so under the cited section of the MPEP the rejection is fatally flawed.

Moreover, as previously, stated, the level of skill in this art is high. The inventor, for example, has a doctorate. The claims themselves deal with determinations to be made in a “complex contract competition”. As such, artisans in this field have a high level of skill, with the result that repeatability is enhanced.

Claims 1-6, 8 and 10-12 are directed to Statutory Subject Matter

Claims 1-6, 8 and 10-12 have been rejected for alleged failure to be directed to statutory subject matter for purported failure to be (1) tied to another statutory class or (2) to be transformative. The examiner states that a method of arbitration is not patentable because human intelligence alone is required. The examiner then asserts that the claimed invention is unpatentable because "mental processes" are involved. The examiner contends that the claimed method does not require a machine and instead relates to "a monetary transaction among manufacturers and retailers". Applicant does not understand this rejection because the preambles to the claims are directed to a method "of competing in a complex contract competition". No reference is made to a retailer, so the rejection is not understood.

As noted, the examiner cited various US patents in prior Office Actions, thus making clear that patents on subject matter of the sort set forth in the claims are allowable. See, for example, Boyd, US Patent No. 6963854 which is directed to a "Target Pricing Mechanism". Hence, the prosecution of this application makes clear that patents are granted for subject matter such as claimed here. Furthermore, the examiner earlier had advised that prior claim 15 was allowable, thus confirming Applicant's position that there is no statutory bar to patentability under 35 USC § 101.

Conclusion

In view of the above, Applicant respectfully requests reconsideration of the rejection of claims 1-6, 8 and 10-14. Applicant asserts that all claims define patentable subject matter.

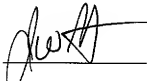
It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please

charge the same to our Deposit Account debit Account 50-0548.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Joe W. Berenato', is written over a horizontal line.

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